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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

EXXON CHEMICAL PATENTS, INC.,
EXXON CORPORATION and
EXXON RESEARCH AND ENGINEERING COMPANY,
Petitioners,

v.

LUBRIZOL CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

AMICUS CURIAE BRIEF OF THE PROCTER & GAMBLE COMPANY IN SUPPORT OF PETITIONERS

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AMICUS CURIAE BRIEF OF THE PROCTER & GAMBLE COMPANY IN SUPPORT OF PETITIONERS

The Procter & Gamble Company together with its subsidiaries ("P&G") files this *amicus curiae* brief in support of Petitioners, Exxon Chemical Patents, Inc., Exxon Corporation and Exxon Research and Engineering Company. P&G has received the consent of both Petitioners and Respondent for the filing of this brief. Correspondence reflecting the parties' position has been lodged with the clerk.

INTEREST OF THE *AMICUS CURIAE*

P&G is an international manufacturer and marketer of consumer goods, including household products such as laundry and cleaning items, food, drug, personal care items such as shampoos, deodorants and cosmetics, nearly all of which are complex compositions of matter containing multiple ingredients.[1] P&G engages in substantial research and development and invests a significant portion of its resources in these areas. P&G relies on the patent system to protect its research investment. P&G has no direct interest in this case; has no interest in any of the parties in this action; nor is P&G a competitor of either Petitioners or Respondent in the field of lubricating oil compositions at dispute in this lawsuit.

The Federal Circuit's holding in this case[2] carries a potentially broad effect. Due to the unique jurisdiction of the Federal Circuit, this split panel decision will govern all future disputes in which the construction of composition of matter claims is at issue. This decision may have enormous economic impact on P&G's business and that of other manufacturers of consumer products who are similarly situated.

P&G respectfully submits that because it is a member of the consumer products manufacturing industry and, through its subsidiaries, manufactures and sells patented products which are potentially affected by the Federal Circuit's decision, yet does not have a direct pecuniary

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[1] P&G products include TIDE, CHEER and BOLD brand detergents; DOWNY and BOUNCE brand fabric softeners; PANTENE, PERT PLUS and HEAD & SHOULDERS brand shampoos; SURE and OLD SPICE brand deodorants; along with dozens of other brands, both in the United States and abroad.

[2] *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 35 U.S.P.Q.2d 1801 (Fed. Cir. 1995); *reh'd denied*, 77 F.3d 450, 37 U.S.P.Q.2d 1767 (Fed. Cir. 1996).

interest in this case, it is in a position to offer useful perspective to the Court.

SUMMARY OF ARGUMENT

The decision in *Exxon* will signal a major departure from the fundamental principles of patent law. First, it will threaten effective patent protection for composition of matter inventions. Second, it will upset the well-established rules of patent claim construction. Third, it will undermine this Court's attempts to bring certainty to the interpretation of patent claims.

In all three respects, the decision in *Exxon* brings confusion to the U.S. patent system. It warrants this Court's review.

By eliminating the simple and time-honored technique of listing ingredients entering into a chemical composition when claiming that composition, the decision in *Exxon* threatens effective patent protection for composition of matter claims. The opinion suggests only an inferior and circuitous route (product-by-process claim language) by which patentees might proceed.

Exxon is a major departure from the conventional interpretation of composition of matter claims. The majority ignores nearly a century of precedent and practice. As Judge Newman so succinctly stated:

> It is incorrect as a matter of law, as a matter of chemistry, and as a matter of patent practice.[3]

Furthermore, the introduction of inconsistency in the drafting and interpretation of patent claims due to the decision in *Exxon* is contrary to this Court's recent attempts to bring more uniformity and certainty to the patent system. The logical result of *Exxon* will be to

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[3] 77 F.3d 450, 451, 37 U.S.P.Q.2d 1767, 1768 (Fed. Cir. 1996) (Newman, J., dissenting).

force inventors of complex composition of matter technology away from patent protection to trade secret protection in order to adequately protect key inventions. This will undermine the whole purpose of the patent system.

This Court should grant certiorari to preserve fundamental patent rights and to maintain the integrity of the United States patent system.

ARGUMENT

I. THE FEDERAL CIRCUIT'S LIMITATION OF COMPOSITION OF MATTER CLAIMS THREATENS EFFECTIVE PATENT PROTECTION

The purpose of claims in a patent is to place the public on "notice" of the afforded scope of protection of the subject patent.[4] The law requires that the claims:

> ". . . reasonably apprise those skilled in the art both of the utilization and scope of invention . . ." [5]

The Federal Circuit's decision in *Exxon* undermines this clear requirement. While the full effect of the decision in *Exxon* has yet to be determined, the court's holding, which effectively concludes that a composition of matter which is claimed by listing the composition's ingredients can no longer be enforced unless none of the ingredients interact, interjects uncertainty and confusion into the construction of composition of matter claims. Composition of matter claims will no longer provide clear "notice" of the scope of protection afforded by such claims.

The standard method for claiming a composition of matter is by listing the ingredients used to formulate the

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[4] *Athletics Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581 (CAFC 1996).

[5] *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 U.S.P.Q. 634, 641 (Fed. Cir. 1985).

composition, together with their amounts and proportions. It is the clearest, easiest, most accurate, and in some circumstances the only, means of claiming a composition which contains multiple ingredients. The ability of an inventor to claim a composition of matter invention by listing the ingredients is confirmed by a leading text on claim drafting.[6] For decades, patent practioners have claimed composition of matter inventions in this matter.[7]

Traditionally, there has been no legal requirement to understand the complexities of one's invention.[8] Typically, little consideration has been given to the possible interactions between the ingredients due to this historical treatment of "ingredient-style" claiming in composition of matter inventions. Determining infringement of a composition of matter patent has heretofore been straightforward: the ingredients added to the accused composition have been compared with the list of ingredients in

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[6] Robert C. Farber, *Landis on Mechanics of Patent Claim Drafting*, § 49, at 148 (3d ed. 1990) cites in relevant part:

> "Composition of matter claims list the chemical ingredients (compounds, elements, or radicals) making up the composition or compound."

[7] See for example the claim at dispute in *Panzel v. Battle Island Paper Co.*, 132 F. 607, 608 (N.D.N.Y. 1904), in which a composition of matter was claimed as a list of ingredients. The claim reads:

> "3. A composition of matter for acid-proof lining of boilers, tanks, and similar vessels, composed of twenty-six per cent. of hydraulic cement, twelve per cent. of chamotte, twenty-one per cent. of quartz and of a suitable quantity of diluted silicate of soda."

[8] "[A]n inventor may be ignorant of the scientific principle, or he may think he knows it yet be uncertain, or he may be confident as to what it is, and others may think differently. All this is immaterial, if by the specification the thing to be done is so set forth that it can be reproduced." *Eames v. Andrews*, 122 U.S. 40, 56 (1887). *See also, Newman v. Quigg*, 877 F.2d 1575, 1581, 11 U.S.P.Q.2d 1340, 1345 (Fed. Cir. 1989).

the patent claim.[9] In short, composition of matter inventions which have been claimed by listing the formulation ingredients added are easy to search and examine for patentability, easy to understand and easy to interpret with respect to both scope and content.

In contrast, the Federal Circuit's decision will require the consideration of all possible interactions between ingredients when interpreting composition of matter claims. This adds a level of complexity and uncertainty unappreciated by the majority. Many composition of matter inventions involve the combination of numerous ingredients. To determine the potential interactions between these ingredients would often be an enormous undertaking requiring a significant expenditure of both financial and human resources. Sophisticated testing equipment and specialized techniques may be needed to determine such interactions. As a result, one skilled in the art will be unable quickly and easily to interpret the claims and ascertain the scope of the claimed invention.

In addition, a number of composition of matter inventions may have interactions so complex as to be indeterminable. Interactions may occur in multi-ingredient compositions to a much greater extent than the relatively simple, five component composition at issue in *Exxon*. These interactions may create unstable systems in which the ingredients are continually forming and reforming into new unknown and/or transient chemical species. In such instances, composition of matter patent protection under the Federal Circuit's decision in *Exxon* will be ineffective since the claims will apparently be unenforce-

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[9] See *American Chemical Paint Co. v. Firestone Steel Products Co.*, 117 F.2d 927, 930-31 (6th Cir. 1941) citing in relevant part:

> "Questions of infringement of patents for compositions of matter are peculiar to themselves. Infringement depends upon the identity or equivalence of the ingredients and upon substantial sameness of the proportions in which the ingredients are used."

able. In sum, the decision in *Exxon* substantially narrows one of the key statutory classes of invention for complex chemical compositions.[10]

A key feature of the current system is the ability to examine a competitor's patent and determine whether or not a product would infringe. In this manner, prospective manufacturers can determine in advance whether entry into the marketplace is allowed. Furthermore, should a prospective new product be likely to infringe the subject patent, its manufacturer must be able to clearly understand the patent claims in order to redesign the product and avoid infringement.[11]

Should the Federal Circuit's decision stand, non-patentee manufacturers may be kept out of the marketplace in complex chemical technologies since significant expense will now be required to investigate any potential interactions between ingredients when determining the scope of composition of matter claims. Competition may be stifled due to the lack of resources or the inability to investigate these complex interactions, without which freedom to practice over a competitor's patent cannot be determined.

In the alternative, the doubt created by the Federal Circuit's new method of claim construction necessarily raises the chances of patentees and competitor's being drawn into complex litigation. With the scope of given composition of matter claims in doubt, competitors may now be emboldened to exploit the previously protected

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[10] 35 U.S.C. § 101 (1988) states in relevant part:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

[11] For a more thorough description of this process known as "designing around" see *Slimfold Mfg. Co. v. Kinkead Industries, Inc.*, 932 F.2d 1453, 1457, 18 U.S.P.Q.2d 1842, 1845-46 (Fed. Cir. 1991).

inventions of patentees. Patent owners will be faced with the prospect of fighting for previously held market position. Litigation will take on the additional complexity of dueling experts testifying in minute detail over supposed interactions (or the lack thereof) between ingredients. The value of the patentees' business will be diminished since their patent portfolios will have been devalued.

Nor is the Federal Circuit's recommended solution a viable alternative. The court suggests that product-by-process claims [12] should be used to overcome the newly created obstacles to ingredient-style composition of matter claims.[13] Product-by-process claims are not specifically provided for in the patent statutes. Rather, the practice and law governing product-by-process claims have developed in response to the need to claim products which resist definition other than by the process by which they are made.[14] In fact, until the early 1970's it was a requirement that the inventor first had to show that the invention could not otherwise be claimed in order to be allowed to use product-by-process claim format. While this is no longer the practice,[15] the bias against product-

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[12] An example of a typical product-by-process claim is: "10. The product produced by the process of claim 1." Also see the claim at issue in *In re Thorpe*, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985).

[13] *Exxon*, 64 F.3d at 1562, 35 U.S.P.Q.2d at 1808 (Plager, *Circuit Judge*, concurring).

[14] See *In re Painter*, 1891 C.D. 200, 57 O.G. 999 (1891), wherein Commissioner of Patents Simonds stated:

> "It requires no argument to establish the proposition that as a rule a claim for an article of manufacture should not be defined by the process of producing that article. On the other hand, when a man has made an invention his right to a patent for it, or his right to a claim properly defining it, is not determined by the limitations of the English language."

[15] See *In re Hughes*, 496 F.2d 1216, 182 U.S.P.Q. 106 (C.C.P.A. 1974) wherein product-by-process claims were permitted even

by-process claim language remains.[16] Thus, it is clear that, while product-by-process claims are recognized, their use is discouraged.

In addition, product-by-process claims are more narrow in their scope of protection than might appear. While the patentability of product-by-process claims is determined by the product itself, for infringement purposes such claims are defined and limited by the process.[17] Thus, the protection afforded by product-by-process claims can be avoided by using a different process to produce the identical product. Accordingly, the Federal Circuit's suggestion in *Exxon* to use product-by-process claims as an alternative to conventional composition of matter claim language is unsuitable for commercially important technology, especially if the invention is complex. Further, the Federal Circuit's suggestion ignores the reality that a large majority of composition of matter patents now in force do not use product-by-process claims. Thus, the decision in *Exxon* deprives a generation of patents of the scope of protection originally expected.

Therefore, it is respectfully submitted that this Court should not allow the Federal Circuit's decision in *Exxon* to undermine effective patent protection for composition of matter inventions.

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though Applicant could describe the invention in structural terms. See also, *In re Pilkington*, 411 F.2d 1345, 162 U.S.P.Q. 145 (C.C.P.A. 1969).

[16] In fact, the Patent and Trademark Office's Manual of Patent Examining Procedure still refers to product-by-process claims as "peculiar". Manual of Patent Examining Procedure § 2113, at 2100-31 (PTO 1995). See also, *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 23 U.S.P.Q.2d 1481, 1481, 1488 (Fed. Cir. 1992).

[17] See *In re Thorpe*, 777 F.2d 695, 697, 227 U.S.P.Q. 964, 965-966 (Fed. Cir. 1985), citing *In re Brown*, 411 F.2d 1345, 1349, 173 U.S.P.Q. 685, 688 (C.C.P.A. 1972); *In re Pilkington*, 459 F.2d 531, 535, 162 U.S.P.Q. 145, 147 (C.C.P.A. 1969); *Buono v. Yankee Maid Dress Corp.*, 26 U.S.P.Q. 57, 61 (2d Cir. 1935).

II. THE FEDERAL CIRCUIT'S DECISION THREATENS WELL ESTABLISHED RULES OF CLAIM CONSTRUCTION

Judge Newman's dissent in response to the Federal Circuit's denial of the petition for rehearing of *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*[18] clearly illustrates the problems associated with changing the way in which composition of matter claims are construed: [19]

> The court's decision in the case of *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 35 USPQ2d 1801 (Fed. Cir. 1995), creates important new law governing the claiming of chemical compositions. Adopted by split panel decision, it is incorrect as a matter of law, as a matter of chemistry, and as a matter of patent practice. The panel majority's new rule of "claim construction" will cast a cloud upon many thousands of existing patents, and major classes of chemical invention will confront unclear, unnecessary, confusing, expensive, and perhaps impossible scientific requirements.

We agree. Unless corrected by this Court, the split panel decision in *Exxon* signals a major departure from the fundamental principles of claim construction for composition of matter claims.

For over a century,[20] patentees have recognized that a composition of matter type invention is best claimed by

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[18] 77 F.3d 450, 451, 37 U.S.P.Q.2d 1767, 1768 (Fed. Cir. 1996).

[19] The process of interpreting claims and assessing the scope that they are to be given is called "claim construction". Courts have viewed this process as being similar to the construction of statutes. "[T]he inability of words to achieve precision is none the less extant with patent claims than it is with statutes. The problem is likely more acute with claims." *Autogiro Co. of Am. v. United States*, 384 F.2d 381, 396 (Ct. Cl. 1967), *cert. denied*, 434 U.S. 1051 (1978).

[20] *See* William C. Robinson, *The Law of Patents for Useful Inventions*, § 192, at 278 (1890)

identifying the ingredients used to make the composition. Indeed, this Court settled the question of composition of matter claim construction over 60 years ago in *Holland Furniture Co. v. Perkin Glue Co.*[21] by stating:

> [a] patent, so far as it is a composition of matter, should contain some description of the ingredients entering into the composition . . .

The Federal Circuit's new interpretation of composition of matter claims directly contradicts this Court's precedent and over 60 years of subsequent decisions.[22] It unnecessarily introduces a new level of complexity and uncertainty into the complicated task of patent drafting and claim construction.[23]

> "A composition of matter is an instrument formed by the intermixture of two or more ingredients, and possessing properties which belong to none of these ingredients in their separate state. An ingredient is a substance which, though capable of independent existence, may yet so far lose its identity and individuality, when mingled with other substances, as no longer to be distinguishable from them."

[21] 277 U.S. 245, 254 (1928).

[22] See, for example, *American Purifyne Co., Inc. v. Novedel Process Corp.*, 3 U.S.P.Q. 180, 185 (2d Cir. 1929),

> "The complaint that the mixture claims give no information by which the mixture could be identified, does not invalidate them. None was necessary because both ingredients of the mixture were known and the means of identifying them were known. This was sufficient identification."

Further see *American Chemical Paint Co. v. Firestone Steel Products Co.*, 117 F.2d 927 (6th Cir. 1941); *Application of Henderson*, 348 F.2d 550, 551 (C.C.P.A. 1965), ("ingredients named in the claims which, when blended within the limits clearly set forth in the claims, provided the new combination for which appellant seeks a patent").

[23] This Court acknowledged the difficulties in patent drafting in *Topliff v. Topliff*, 145 U.S. 156, 171 (1892),

> "The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most

Moreover, such changes in the way composition of matter claims are to be construed materially affect the patent assets of all assignees and licensees. U.S. Companies own literally thousands of patents as well as licenses to practice under patents assigned to others. These patents were issued and the licenses concluded based on a clear understanding of the claims under well established rules of claim construction. To change the method of claim construction now will throw considerable doubt on composition of matter claims in a patentee's or assignee's portfolio. This changes the bargained-for position of parties who entered into license agreements under long-accepted principles of claim construction.

Since composition of matter claims will no longer be interpreted based on the ingredients entering into the composition, chemical analysis will be required to determine whether the ingredients retain their original form within the composition, or have undergone chemical reactions to produce unsuspected components not specifically enumerated in the claims. Small or unsophisticated competitors will be at a particular disadvantage if detailed and expensive analyses are needed to determine the scope of claim coverage. All businesses will be forced to pass these costs on to consumers.

Therefore, it is submitted that the Federal Circuit's decision not only casts doubt on the established patent rights of patent owners and licensees who rely on composition of matter inventions, but also creates the need for expensive research to determine the actual scope of existing claims.

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difficult legal instruments to draw with accuracy . . . to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention."

III. THE FEDERAL CIRCUIT'S DECISION FRUSTRATES THIS COURT'S ATTEMPTS TO BRING CERTAINTY TO CLAIM INTERPRETATION

Clause 8, section 8, Article I of the Constitution of the United States gives Congress the power:

> [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

The United States Patent System is widely recognized as a successful means for providing an incentive to invest in research, development and innovation. Moreover, the patent system encourages early public disclosure of information by granting exclusive rights to the patentee versus an inventor who chooses to keep his or her invention secret.[24]

The need for certain and uniform application of the rules of claim construction has been long recognized as a necessary cornerstone of the patent system. Uniform and consistent application of the rules of patent claim construction allows patentees and prospective competitors to arrive at a reasonably consistent interpretation of the

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[24] See *Bauer & Cie v. O'Donnell*, 229 U.S. 1, 10 (1913) in which the Court stated that the purpose of the Patent Act was in the encouragement of useful invention and was intended to secure to the public, after lapse of exclusive privileges granted, the benefit of such inventions and improvements. The differences between patent protection and trade secret protection were explained by the court in *Tower Mfg. Co., Inc. v. Monsanto Chemical Works*, 20 F.2d 386, 387 (D.C.N.Y. 1927)

> "The outstanding difference is that a patentee has a monopoly as against all the world, while the owner of a secret process has no right, except against those who have contracted, expressly or by implication, to disclose the secret, or who have obtained it by unfair means."

scope of patent rights.[25] This Court quite recently recognized the importance of uniform claim construction in *Markman v. Westview Instruments, Inc.*[26]

> As we noted in *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938), "the limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." Otherwise, a "zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field." *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) . . . It is just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate courts for patent cases. H.R. Rep. No. 97-312, pp. 20-23 (1981), observing that increased uniformity would "strengthen the United States patent system in such a way as to foster technological growth and industrial innovation." *Id.*, at 20.

Moreover, this Court recently granted certiorari in *Hilton Davis*[27] to resolve the lower courts' confused application of the doctrine of equivalents in patent infringement cases.

Notwithstanding this Court's goal to increase uniformity and certainty, the Federal Circuit has now introduced

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[25] *Merrill v. Yeomans*, 94 U.S. 568, 573-74 (1876)

> "It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent."

[26] 134 L.Ed.2d 577, 38 U.S.P.Q.2d 1461 (U.S. 1996).

[27] *Hilton Davis Chemical Co. v. Warner-Jenkinson Company, Inc.*, 62 F.3d 1512, 35 U.S.P.Q.2d 1641 (Fed. Cir. 1995), *cert. granted*, 116 S. Ct. 1014 (1996).

inconsistency and confusion into the interpretation of composition of matter claims. In one stroke, the decision in *Exxon* deprives both the patentee and prospective competitors of the ability to know where they stand when bringing products into the market. The unintended, but likely, result of *Exxon* will be to force inventors of complex composition of matter technology away from patent protection to trade secret protection in order to adequately protect key inventions. This defeats not only this Court's goal of patent uniformity, but also the constitutional goal promoting the useful arts via the patent system.

It is respectfully submitted that the uncertainties now introduced by the Federal Circuit in *Exxon* involving the literal interpretation of composition of matter claims profoundly affect the patent system and are at least as worthy of consideration by this Court as the issues in *Markman* and *Hilton Davis*.

CONCLUSION

For the reasons set forth above, this Court should grant the petition for a writ of certiorari.

Respectfully submitted,

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